

Application Number: 10/692,217
Reply Dated: May 22, 2009
Office Action Dated: December 23, 2008

REMARKS

This paper is responsive to the Office Action dated December 23, 2008, for which a three (3) month period of response was given. A petition and fee for a two (2) month extension of time hereby accompanies this paper. Should further extensions of time and/or additional claim fees be due, the Commissioner is hereby authorized to treat this paper as a Petition for any needed extension of time and to charge any fees due to Deposit Account No. 50-0959, Attorney Docket No. 109770.0018.

Claims 1 through 30 are pending in this application. In view of the above, entry of the amendments and consideration of the remarks which follow is respectfully requested.

I. Objection to Specification:

The specification has been corrected as requested. Withdrawal of the objection of the disclosure is respectfully requested.

II. The 35 U.S.C. § 103 Rejections:

Claims 11, 12, 15 through 19, 21 through 23, 26 through 28 and 30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Fevre (U.S. Patent No. 5,758,545). Fevre et al. is directed to a depth adjustable steering column for a motor vehicle containing an inner tube that slides into an outer tube, and a sheath disposed between said tubes. In one embodiment, the sheath has a scalloped configuration that creates projecting elements disposed longitudinally on the inner and outer surface of the sheath which are in contact with the inner and outer tubes.

The present invention is directed to an axially adjustable steering column assembly with a flexible bearing sleeve. The assembly includes an inner jacket that is telescopically received within an outer jacket with a ribbed sleeve at the telescoping interface of the inner and outer jackets. The sleeve consists of a cylindrical wall, which is parallel with the outer and inner jackets, that contains at least one internal rib that extends inward from the inner surface of the sleeve and at least one external rib that extends outward from the outer surface of the sleeve.

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The Examiner finds the shape of the wall contained between the internal and external ribs of an inconsequential nature. However, there is a particular reason and purpose for the wall being flat between the internal and external ribs and being parallel to the jackets. The sleeve can be attached to the outer jacket in one of two ways described in the specification. First, a bonding agent can be located between the sleeve and outer jacket allowing the sleeve to be fixedly secured to the outer jacket with the internal ribs of the sleeve sliding against the outer surface of the inner jacket. Alternatively, the sleeve may be friction fit within the outer jacket by contact of biasing ribs located radially opposite selected internal ribs or radially opposite each of the internal ribs, with external ribs positioned radially between. Both methods for attaching the sleeve to the outer jacket rely on the structure and design of the sleeve. The flat wall surface increases the amount of surface area between the ribs thereby permitting secure bonding of the sleeve to the outer jacket. The friction fit requires the biasing ribs to eliminate the need for a bonding material by compressing the external ribs against the interior of the outer jacket to securely position the sleeve between the two jackets. Fevre et al. relies upon a block formed on the sheath and opening in the outer tube to secure the sheath to the outer tube. Here, the outer jacket must also be specifically modified to accept the block in order to secure the sheath in place. The difference in shape of the sleeve in the present invention and the sheath of Fevre et al. does make a difference depending on the particular method chose for securing the sleeve to the outer jacket. Therefore, the shape of the wall is not an obvious matter of design choice but serves a specific and useful purpose. Withdrawal of the rejection of claims 11, 12, 15 through 19, 21 through 23, 26 through 28 and 30 is respectfully requested.

Claims 1 through 3, 5 through 10, 13, 20, 24 and 29 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Fevre et al. in view of Burkhard et al. (U.S. Patent No. 5,722,300). All of the secondary and tertiary references have been previously distinguished from the claimed invention by the previous amendments and remarks in support thereof, and by the appeal which resulted in withdrawal of the rejections based thereon.

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Burkhard et al. is directed to a motor vehicle steering column having a first jacket element, a second jacket element telescoped into a cylindrical passage in the first element, and a split bushing between the first and second elements. According to the Examiner, positioning the end of the inner jacket within the sleeve is taught by Burkhard et al. so therefore it would have been obvious to one of ordinary skill in the art to position the end of the inner jacket within the sleeve. Applicant respectfully disagrees. First, the inner element of Burkhard et al. does not come into contact with the bushing. An energy absorber and a center element are disposed between the inner element and bushing. Burkhard et al.'s placement of the end of the inner jacket within the sleeve does not take into account the situation where the sleeve and inner jacket are within direct contact with one another. Therefore, it would not be obvious, given Burkhard et al., to place the end of the inner jacket within and in direct contact with the sleeve. Also, regarding the shape of the wall between the internal and external ribs, as argued above, the shape of the wall has a particular utility as applied to the present invention.

The Examiner further finds that arranging biasing ribs aligned with the internal ribs would be obvious in view of the tongue mechanism of Fevre et al. and the spheres of Burkhard et al. Again, Applicant respectfully disagrees. Neither the tongue mechanism of Fevre nor the spheres of Burkhard et al. are "sleeves" as described in the present invention. Claims 3, 13 and 24 describe at least one biasing rib on an exterior *sleeve wall* and which is radially aligned with an internal rib of the *sleeve*. Given that neither of the cited art describe biasing ribs in conjunction with a "sleeve" or a "sleeve wall" it would not be obvious to arrange the ribs of a sleeve in the manner claimed in claims 3, 13 and 24. Furthermore, the surface of the spheres described in Burkhard et al. do not engage the inner and outer jackets but instead engage the inner element and the center element.

Regarding claim 29, the Examiner finds that forming the wall of the sleeve thicker than the ribs would be obvious in the combination as taught by the spheres of Burkhard et al., which have surfaces extending toward and contacting facing walls of jackets that do not extend a distance from the sleeve that is equal to the sleeves thickness. Burkhard et al.

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does not disclose a sleeve of the claimed configuration and the spheres function in an entirely different manner.

Given the above, it is therefore respectfully requested that the rejections of claims 1 through 3, 5 through 10, 13, 20, 24 and 29 be withdrawn.

Claims 14 and 25 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Fevre et al. in view of Barton et al. (U.S. Patent No. 6,389,923). Barton et al. is directed to a length-adjustable shaft for a vehicle steering column assembly. The Examiner finds that it would have been obvious to modify Fevre et al. to include a bonding agent between the sleeve and outer jacket as taught by Barton et al. in order to better retain the sleeve securely within the outer tube. However, the "bush" as disclosed in Barton et al. is not in the form of a cylindrical sleeve and does not secure a cylindrical sleeve to a cylindrical jacket. As such, it would not have been obvious to combine the teachings of Fevre et al. and Barton et al. Withdrawal of the rejection to claims 14 and 25 is respectfully requested.

Claim 4 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Fevre et al. in view of Burkhard et al. as applied to claim 1, and further in view of Barton et al. As argued above, given that Barton et al. does not disclose the attachment of a cylindrical sleeve to a cylindrical jacket it would not be obvious to combine the teachings of Barton et al., Fevre et al. and Burkhard et al. Additionally, given that the rejection to claim 1 has been overcome, it is respectfully requested that the rejection to claim 4 also be withdrawn.

Claims 11, 12, 15 through 19, 21 through 23, 26 through 28 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fevre et al. in view of Milton et al. (U.S. Patent No. 3,703,105). Milton et al. is directed to a collapsible shift tube assembly for a steering column. The Examiner finds that it would have been obvious to modify Fevre et al. to include walls of the sleeve between the inner and outer ribs parallel to and equally spaced from the jackets in view of Milton et al.'s sleeve. The steering column disclosed in Milton et al. is not a telescoping steering column as claimed in the present invention. The steering column contains a locking sleeve with tabs which are received within slots located on a lower member to provide firm engagement between the sleeve and the upper and lower members. An engagement between the upper and lower member results from the

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reception of tabs within the slots located on the lower member. The purpose of the tabbed sleeve of Milton et al. is to "prevent axially inward collapse of the shift tube assembly" and to thereby provide a "rigid assembly". This does not comply with the purpose and design of the ribbed sleeve of the present invention. There are no interlocking parts between the inner and outer jacket and the sleeve is provided as a mechanism to facilitate telescoping movement between the inner and outer jacket.

The Examiner is attempting to use hindsight to reconstruct the invention as recited in the above-mentioned claims. It is well settled that hindsight is impermissible. As was stated by the Supreme Court in *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 82 USPQ2d 1385, 1396 (2007):

As is clear from cases such as *Adams*, a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.

Furthermore, as was stated by the Federal Circuit in *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 221 USPQ 929, 932, 933 (Fed. Cir. 1984):

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 104, teachings of reference can be combined only if there is some suggestion or incentive to do so.

As would be apparent to one of skill in the art, such suggestion and/or incentive to combine the prior art in the manner suggested by the Examiner is clearly lacking in the instant case absent the impermissible use of hindsight. As was stated by the Federal Circuit in *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992):

It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the

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teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." (quoting *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988)).

Accordingly, given the above, the combinations of Fevre et al, Burkhard et al, and Milton et al, as applied to claims 1 through 3, 5 through 10, 13, 20, 24 and 29, are based on the impermissible use of hindsight. As such withdrawal of the rejections of these claims over the combinations of Fevre et al, Burkhard et al, and Milton et al is believed due and is respectfully requested.

Claims 1 through 3, 5 through 10, 13, 20, 24 and 29 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Fevre et al., in view of Burkhard et al. and Milton et al. The Examiner finds that it would have been obvious to modify Fevre et al. to include the end of the inner jacket positioned within the sleeve as taught by Burkhard et al. Given the Examiner's use of impermissible hindsight regarding this combination of prior art, as discussed above, in addition to the previous arguments made in this paper regarding the rejection of these claims over Fevre et al. and Burkhard et al., it is respectfully requested that the rejection to claims 1 through 3, 5 through 10, 13, 20, 24 and 29 over Fevre et al, Burkhard et al and Milton et al. be withdrawn.

IV. Conclusion:

Accordingly, reconsideration and withdrawal of the specification objection and 35 U.S.C. § 103(a) rejections is believed due and is respectfully requested.

For at least the foregoing reasons, claims 1 through 30 of the present application are believed to be in condition for allowance, and a Notice of Allowance is respectfully requested. Should the Examiner wish to discuss any of the foregoing in more detail, the undersigned attorney would welcome a telephone call.

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Respectfully submitted,



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May 26, 2009

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